

REMARKS

Claims 1-26 and 34-39 are currently pending in this application. All previous rejections of record have been expressly withdrawn.

The Office Action

Claims 1-26 and 34-39 were rejected under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse the foregoing rejection.

The Rejection Based On Obviousness-type Double Patenting

As stated above, Claims 1-26 and 34-39 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 of U.S. Patent No. 6,706,816. 37 CFR §1.109(a) provides, in pertinent part:

A double patenting rejection will be made in an application or patent under examination if the application or patent under examination claims as invention that is not patentably distinct from an invention claimed in a commonly owned patent. *** A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

Thus, the apparent basis for the present obviousness-type double patenting rejection is that Claims 1-26 and 34-39 of the present application are not patentably distinct from Claims 1-7 of the '816 patent. Although the present rejection can be obviated by filing a terminal disclaimer, the present rejection is clearly improper.

The present application is a division of application Serial No. 09/903,230 filed July 11, 2001, now U.S. Patent No. 6,706,816. In this parent application, Claims 1-37 were initially included in the application as filed. On November 21, 2002, an Office Action

was issued requiring an election of invention. The Office Action stated that the application included six separate and patentably distinct inventions. Those separate inventions were identified as Group I, which comprised Claims 1-18; Group II, which comprised Claims 19-23, 34 and 35; Group III, which comprised Claim 24; Group IV, which comprised Claims 25 and 26; Group V, which comprised Claims 27-33 and Group VI, which comprised Claims 36 and 37. The Office Action further stated that, "[b]ecause these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper."

37 CFR §1.142 provides

If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division).

Thus, by making the foregoing restriction requirement, it is irrefutable that the Office took the position that the inventions of the various Groups were patentably distinct.

In response to this restriction requirement, the applicants elected the invention of Group V, which comprised Claims 27-33. The election was made with traverse on the grounds that the inventions of Groups I and VI were so closely related that the search for each claim would overlap. In an Office Action mailed April 16, 2003, the patent examiner noted the traverse, but found the reasons unpersuasive. Therefore, the restriction requirement was maintained. Claims 27-33 of Serial No. 09/903,230 were allowed in the Notice of Allowance mailed September 2, 2003, and became Claims 1-7 of the '816 patent.

When applicants filed the present divisional application, it included Claims 1-26 and 34-37 which were the non-elected claims from the original parent application.

By the Office's own restriction requirement in the parent application, Claims 1-26 and 34-37 had been found to be patentably distinct from Claims 1-7 of the '816 patent.

Although some of Claims 1-26 and 34-37 were amended during prosecution, these amendments were only formal in nature. The only rejection of those claims was under 35 U.S.C. §112. The amendments only clarified existing elements of the claims; they did not add, delete or change elements in the claims. New Claims 38 and 39 were also added during prosecution. However, none of the amended or new Claims 1-26 and 34-39 changed the scope of the claims as originally filed in the parent application. For example, amended Claims 19 and 20 and new Claims 38 and 39 are article claims. However, article Claims 34 and 35 were included in the original Claims 1-26 and 34-37 of the parent application. Thus, it is respectfully submitted that the scope of the claims did not change during prosecution.

By issuing the present obviousness-type double patenting rejection, despite its prior determination, the Office is now contending that Claims 1-26 and 34-39 of the present application are not patentably distinct from Claims 1-7 of the '816 patent. The Office should not be permitted to have it both ways. It should not be permitted to issue a restriction requirement on the basis of multiple patentably distinct inventions and then issue a double patenting rejection on the basis that the invention of the current claims are not patentably distinct from those in the issued parent patent. The Office should be estopped to make such contradictory determinations. Moreover, the MPEP §804 states, "[g]enerally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in the parent application under 35 U.S.C. 121." Thus, the current rejection violates the Office's own rules.

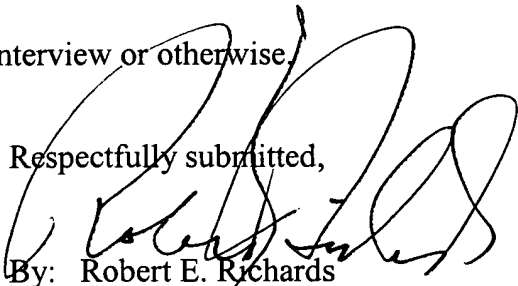
The actions of the Office in withdrawing the Notice of Allowance in the present application and issuing the present groundless obviousness-type double patenting rejection has unnecessarily extended the prosecution of this application and unnecessarily increased the expense to the applicants.

Applicants contend that Claims 1-26 and 34-39 of the present application are patentably distinct from Claims 1-7 of the '816 patent on the same basis as set forth for the restriction requirement in the parent application. Accordingly, applicants respectfully submit that the present rejection of Claims 1-26 and 34-39 based on obviousness-type double patenting is improper and should be withdrawn.

Conclusion

Applicants respectfully request reconsideration of the present application in view of the foregoing remarks. Such action is courteously solicited. Applicants further request that the Examiner call the undersigned counsel if allowance of the claims can be facilitated by examiner's amendment, telephone interview or otherwise.

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